

Remarks

After cancellation of claims 17-23, 28-61, 71-76, and 81-89 and entry of the foregoing amendments, claims 24-27, 62-70, 77-80 and 90-127 will be pending in the application, with claims 62, 70, 90, 98, 106, 114 and 121 being the independent claims.

I. The Restriction Requirement

The Examiner has restricted the originally filed claims into the following groups:

- I.** Claims 17-23, 28-34, 37-43, 46-51, 54-59, drawn to a polypeptide of SEQ ID NO:4, classified in class 530, subclass 326, 324, 350.
- II.** Claims 24, 35, 44, 52 and 60, drawn to an antibody against polypeptide SEQ ID NO:4, classified in class 530, subclass 387.1.
- III.** Claims 25, 36, 45, 53, 61, drawn to a method of detecting polypeptide SEQ ID NO:4, classified in class 435, subclass 7.1.
- IV.** Claims 26-27, drawn to a method of treatment by Galectin 9 (SEQ ID NO:4), classified in class 514, subclass 2.
- V.** Claims 62-67, drawn to an isolated protein comprising amino acid residues encoded by a first polynucleotide which hybridizes to a second polynucleotide having the nucleotide sequence of the coding region of SEQ ID NO:3, classified in class 530, subclass 350.
- VI.** Claim 68, drawn to an antibody against the protein of group V, classified in class 530, subclass 387.1.
- VII.** Claim 69, drawn to a method of detecting the protein of Group V, classified in class 435, subclass 7.1.
- VIII.** Claims 70-76, 81-87, drawn to a polypeptide of SEQ ID NO:8, classified in class 530, subclass 350.
- IX.** Claims 77 and 88, drawn to an antibody against SEQ ID NO:8, classified in class 530, subclass 387.1.

- X. Claims 78 and 89, drawn to a method for detecting Galectin 10, classified in class 435, subclass 7.1.
- XI. Claims 79-80, drawn to a method of treating a disorder with Galectin, classified in class 514, subclass 2.

Applicants respectfully traverse the restriction requirement as it applies to each of Groups I-XI.

In brief, it is the Examiner's position that Group I-XI "are distinct and . . . have acquired separate status in the art" (Paper No. 8, page 4.)

Applicants point out that, even where two patentably distinct inventions appear in a single application, restriction remains improper unless the Examiner can show that the search and examination of both groups would entail a "serious burden". (*See* M.P.E.P. § 803.) In the present situation, the Examiner has failed to make such a showing.

With respect to Groups I and V, Applicants note that the subject matter of Group I includes proteins comprising amino acid sequences at least 95% identical to amino acid sequences disclosed in SEQ ID NO:4. Further, the subject matter of Group V includes, in relevant part, proteins comprising amino acid residues encoded by a first polynucleotide which hybridizes to a second polynucleotide having the nucleotide sequence of the coding region of SEQ ID NO:3. Applicants point out that SEQ ID NO:3 encodes the amino acid sequence shown in SEQ ID NO:4. Thus, there is substantial overlap between the subject matter of Groups I and V. Further, searches of the subject matter of Groups I and V would also overlap. Applicants thus assert that it would not be a substantial burden upon the Examiner to examine the subject matter of Groups I and V together.

With respect to Galectin 9 (Groups I-VII) and Galectin 10SV (Groups VIII-XI) in general, Applicants note that these proteins have similar functional activities. Thus, searches of the subject matter of Groups I-XI would again overlap.

Applicants also note that the subject matter of Groups II-IV and VI-VII (antibodies, detection methods, and methods for treating disorders) are each linked to the Galectin 9 proteins of Groups I and V. Further, the subject matter of Groups IX-XI (antibodies, detection methods, and methods for treating disorders) are each linked to the Galectin 10 proteins of Group VIII. Thus, Applicants again note that searches of the subject matter of Groups I-XI would clearly be overlapping.

In view of the above comments, Applicants assert that examination of the subject matter of Groups I-XI would not entail a "serious burden" and the restriction requirement should be withdrawn.

Applicants further note that, as a result of the decisions in *In re Ochiai*, 37 U.S.P.Q.2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 37 U.S.P.Q.2d 1663 (Fed. Cir. 1996), a notice was published in the Official Gazette which sets forth guidelines for the treatment of biotechnological product and process claims. *See* 1184 O.G. 86 (March 26, 1996). This notice states in relevant part:

[W]here product and process claims are presented in the same application, applicant may be called upon under 35 U.S.C. § 121 to elect claims to either the product or the process. . . . However, in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim.

1184 O.G. 86 (March 26, 1996).

Claims 26-27 are directed to processes for using isolated proteins of claim 90. Applicants thus respectfully request that the Examiner rejoin and examine for patentability these process claims if claim 90 is found to be in condition for allowance.

Further, claims 79-80 are directed to processes for using isolated proteins of claim 70. Applicants thus respectfully request that the Examiner rejoin and examine for patentability these process claims if claim 70 is examined and found to be in condition for allowance.

Applicants note that new claims 90-127, submitted herewith, represent the subject matter of Group I, which is provisionally elected herein.

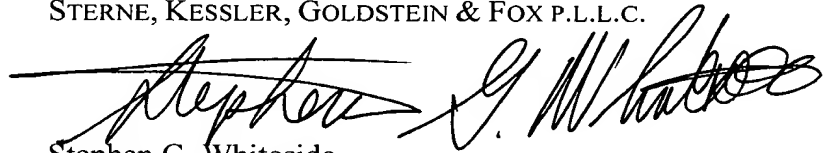
Conclusion

It is respectfully believed that this application is now in condition for substantive examination. Early notice to this effect is respectfully requested.

It is not believed that extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

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